

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Huffman et al.	Art Unit :	3692
Patent No. :	7,505,936	Examiner :	Clement B. Graham
Issue Date :	March 17, 2009	Conf. No. :	4550
Serial No. :	09/940,276		
Filed :	August 27, 2001		
Title :	DIGITAL CONTENT SUBSCRIPTION CONDITIONING SYSTEM		

Commissioner for Patents
P.O. Box 1450
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 1619 to 2169 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

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failure of the United States Patent and Trademark Office to issue a patent within 3 years.”
“B delay” begins only after the PTO has failed to issue a patent within three years, not before.
Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before October 27, 2002 (the date that is fourteen months after August 27, 2001, the date on which the application was filed). The PTO mailed the first non-final Office Action on September 26, 2006, thereby according a PTO Delay of 1430 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from October 28, 2002 (the day after the date that is fourteen months after the date on which the application was filed), to September 26, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

Patent issuance was due on or before September 16, 2008 (the date that is four months after May 16, 2008, the date on which the issue fee was paid). The PTO issued a patent on March 17, 2009, thereby according a PTO Delay of 182 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from September 17, 2008 (the day after the date that is four months after the date on which the issue fee was paid), to March 17, 2009.
See 37 C.F.R. §§ 1.702(a)(4) and 1.703(a)(6).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 1612 days.

“B Delay”

The period beginning on August 28, 2004 (the day after the date that is three years after August 27, 2001, the date on which the application was filed), and ending March 17, 2009 (the date the patent was issued), is 1663 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, no Request for Continued Examination was filed.
See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 1663 days. The PTO calculated 51 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 1663 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

June 24, 2003, to September 26, 2006; and

September 17, 2008, to March 17, 2009.

As detailed above, "B Delay" accumulated during the following period:

August 28, 2004, to March 17, 2009.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day) for a total of 942 days, from August 28, 2004 to September 26, 2006, and from September 17, 2008, to March 17, 2009.

Applicant Delay

A reply to an Office Action was due on or before December 26, 2006 (the date that is three months after September 26, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on January 26, 2007, thereby according an Applicant Delay of 31 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from December 27, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to January 26, 2007. See 37 C.F.R. § 1.704(b).

Patentee filed an Information Disclosure Statement on November 28, 2007, subsequent to a reply filed on November 15, 2007. Patentee was accorded a delay of 13 days for a

supplemental response. Patentee does not dispute the PTO's calculation for this Applicant Delay from November 16, 2007, to November 28, 2007. See 37 C.F.R. § 1.704(c)(8).

Patentee filed a supplemental reply on March 17, 2008, subsequent to a Notice of Allowance mailed by the PTO on March 5, 2008. An Applicant Delay of 0 days was thus accorded; however, in good faith and candor, Patentee submits that the supplemental reply to the Office Action should have been accorded a total Applicant Delay of 120 days for delay from March 18, 2008 to July 15, 2008. See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 164 days (i.e., the sum of 31 days, 13 days and 120 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 1619 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 2333 days (i.e., the sum of 1612 days of "A Delay" and 1663 days of "B Delay" minus 942 days of overlap);
- 2) Total Applicant Delay should be calculated as 164 days (i.e., the sum of 31 days, 13 days, and 120 days); and
- 3) Total PTA should be calculated as 2169 days.

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The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 12587-0010001.

Respectfully submitted,

Date: May 12, 2009

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